



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/618,395 | 07/11/2003 | Ian W. Cunningham | 5658/937 | 5505 |
| 24239 | 7590 | 02/22/2006 | EXAMINER | |
| MOORE & VAN ALLEN PLLC P.O. BOX 13706 Research Triangle Park, NC 27709 | | | FIDEI, DAVID | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3728 | |

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/618,395 | Applicant(s) CUNNINGHAM ET AL | |
| | Examiner David T. Fidei | Art Unit 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 19-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 33-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/17/03, 12/5/03, 9/13/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 19-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed December 12, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11, 17, 18, 37-40 and 43-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Roberts (Patent no. 5,137,209). A product storage and display container is disclosed comprising a receptacle 1, what is considered a display tag 13 in as much as is claimed, an engagement element and receiving element 45, 47 and 21.

In the alternative, as claimed the receiving element can be considered the flanges on the barbs or hook members, 45, 47 and the engagement element the wall around the aperture 21.

As to claims 4 and 11, a lid is defined around perforations 11 that define an opening.

As to claim 17, the tag is manifestly considered removable.

As to claim 18, raised annular rings 42, 43 are shown in figure 3.

As to claims 37-39, In order to further limit the claim there must be some distinction based upon the intended use recited. "However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art, see M.P.E.P. § 2111.02 THE INTENDED USE MAY FURTHER LIMIT THE CLAIM IF IT DOES MORE THAN MERELY STATE PURPOSE OR INTENDED USE. The examiner can see no structural

Art Unit: 3728

differences between the claimed invention and the prior art based upon the intended use recited. Accordingly, these claims are define nothing novel over Roberts.

As to claim 40 and 43-46, the main body tag comprises a slot 75 or 77 defined there through and an attachment means 45, 47 defined thereon. The object 1 has cooperating means 21 thereon for rotatable attachment to the attachment means.¹

As to claim 41, the attachment means further comprises a raised annular ring at 42, 43.

4. Claims 1-5, 11-14, 17 and 37-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Weisburn (Patent no. 5,5509,538). A product storage and display container is disclosed comprising a receptacle 2, a display tag 3, an engagement element and receiving element 20 and 34, where either one can be considered and an engagement element or vise versa.

As to claims 12-14, the lid further comprises a tab closure system 16 that is a snap lock tab connected by a living hinge to the lid. This information is gleaned though reference to application 08/0082,632 that matured to patent no. 5,390,515. In figures 5 and 6 of this patent one can readily see the living hinge of the snap-lock tab.

As to the remaining claims since the display tag 3 may be mounted in positions 90 degrees relative to one another, the tag is rotatably² attached to the container in as much as is claimed.

Claim Rejections - 35 USC § 103

¹ In determining anticipation as established above, the examiner finds that the prior art element performs the function specified in the claim, and is not excluded by any definition provided in the specification for an equivalent. Therefore, it is inferred from that finding that the prior art element is an equivalent, and the claimed limitation is anticipated by the prior art element. As such, the burden shifts to applicant to show that any aforementioned equivalent element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. In re Mulder, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983).

If the applicant disagrees with the inference of equivalence drawn from a prior art reference, the applicant may provide reasons why the applicant believes the prior art element should not be considered an equivalent to the specific structure, material or acts disclosed in the specification. Such reasons may include, but are not limited to: 1) teachings in the specification that particular prior art is not equivalent, 2) teachings in the prior art reference itself that may tend to show non-equivalence, or 3) Rule 132 affidavit evidence of facts tending to show non-equivalence.

Moreover, if an applicant argues that the "means" or "step" plus function language in a claim is limited to certain specific structural or additional functional characteristics (as opposed to "equivalents" thereof) where the specification does not describe the invention as being only those specific characteristics, the claim should be not allowed until the claim is amended to recite those specific structural or additional functional characteristics (emphasis added). See 1162 OG 61, May 17, 1994.

² To turn around on an axis or center, dictionary.com (rotatable).

Art Unit: 3728

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (Patent no. 5,137,209). Roberts discloses a container which soap or detergent powder is packaged. The difference between the claimed subject matter and Roberts resides in a plurality of products housed in the container (claim 33) and the products being a plurality of tool bits.

Official Notice is notoriously old and well known to use household packages to hold other contents one the original product has been consumed or used. Boxes, pails or other containers are often used around the house to hold other contents. It would have been obvious to one skilled in the art at the time the invention was made to employ the container of Roberts to hold a plurality of products such as tool bits in view of Official Notice, in order to provide a secondary utility to the package, obviating the need to buy additional storage containers.

8. Claims 15, 16 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (Patent no. 5,137,209). Roberts discloses the claimed subject matter except for an anti-theft device.

Official Notice is taken for the use of anti-theft devices in the packaging industry. Packages, boxes, apparel, etc., are customarily provide with devices that set off alarms or some other type of device which alerts a merchant of a product removal. It would have been obvious

Art Unit: 3728

to one skilled in the art at the time the invention was made to include an anti-theft device on the container of Roberts in view of Official Notice, in order to deter removal of the product without paying for it.

The particular location of the anti-theft device, i.e., on the lid, cover, side wall, etc., is considered a matter of design choice.

REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION

9. “In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant’s or patent owner’s reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. The reply must be reduced to writing (emphasis added)”, see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner’s action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.


Art Unit: 3728

The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The Official Fax number to file responses to this Office Action is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David T. Fidei
Primary Examiner
Art Unit 3728

dtf
February 21, 2006